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09/628,607	07/31/2000	Margaret A. Moore	50160/002003	3849

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CLARK & ELBING LLP  
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BOSTON, MA 02110

EXAMINER
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POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/628,607

Applicant(s)

MOORE, MARGARET A.

Examiner

Melvin H. Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-16, 19-23, 26-28, 31, 32 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16, 19-23, 26-28, 31, 32 and 34-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: see attached office action.

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 2-16, 19-23, 26-28, 31, 32, and 34-40 are withdrawn in view of the newly discovered reference(s) to Lauffer (6,546,372) and Douglas (6,039,688).

Rejections based on the newly cited reference(s) follow.

2. Prosecution on the merits of this application is reopened on claims 2-16, 19-23, 26-28, 31, 32, and 34-40 considered unpatentable for the reasons indicated below:

The new art reads on the current claim limitations.

3. Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

### ***Response to Amendment***

4. The declaration under 37 CFR 1.132 filed 1/19/06 is insufficient to overcome the rejection of claims 2-16, 19-23, 26-28, 31, 32, and 34-40 based upon a 103 obviousness rejection as set forth in the last Office action because: the evidence and facts provided are insufficient to establish unexpected results or business success.

5. It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

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6. It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

7. Furthermore, the requirements of such affidavits are that they provide objective, detailed information that the combination provides results that a person of ordinary skill in the art could not have predicted, or that shows that the combination of elements alone leads to business successes that could not have been achieved by any other combination or attributable to any other factors. Opinion testimonials such as various awards are not by themselves sufficient to win on this point, as they lack the necessary objectivity and detail to show non-obviousness.

8. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 40 is rejected under 35 U.S.C. 102(e) as being anticipated by Douglas (6,039,688).

11. For claim 40, Douglas teaches a method (abstract; col. 1, line 1 – col. 5, line 25; col. 22, lines 10-45) by which a company (col. 2, line 18, HMOs) provides interactive, ongoing coaching

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to a plurality of clients using non-e-mail-based Internet communication (col. 19, lines 12-14) as well as e-mail based communications (col. 19, line 8), said method comprising providing multiple coaches/physicians (col. 19, line 11) who have access to a common web platform (Fig. 34; col. 2, line 54; col. 16, lines 40-45). Douglas teaches providing health related advice (Figs. 27, 28, 31) to patients and personal goals achievements information (Figs. 41, 43, 44), having the client and coach access a file that contains information that is personal to the client (Fig. 39).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-16, 19, 21, 23, 28, 31, 32, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer (6,546,372) in view of Douglas (6,039,688).

14. For claim 40, Lauffer discloses a method by which a company (col. 1, line 34) provides interactive, ongoing coaching to a plurality of clients (col. 1, line 31) using non-e-mail based internet communications (col. 2, lines 19-20) as well as e-mail based communications (col. 2, line 17), the method comprising providing experts (coaches)(col. 1, line 34) who have access to a common web platform (i.e., internet; col. 2, line 16).

15. Lauffer teaches experts providing advice to consumers using the Internet and email.

16. Lauffer does not specifically specify that the advice be related to health and personal goals.

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17. However, Douglas teaches providing health related advice (Figs. 27, 28, 31) to patients and personal goals achievements information (Figs. 41, 43, 44), having the client and coach access a file that contains information that is personal to the client (Fig. 39).

18. It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

19. For claim 2, Lauffer teaches wherein, in steps f-h), the client and the coach communicate over the Internet at scheduled times (col. 8, line 55 – col. 9, line 25), with real-time dialogue (col. 4, line 65 – col. 5, line 5; col. 6, lines 5-15), but does not expressly disclose that the communication is in the form of "chat" format typed comments and questions. Douglas teaches this limitation (col. 11, line 5 – col. 13, line 50). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

20. For claim 3, Lauffer teaches wherein, in steps f-h), the client and the coach communicate over the Internet at scheduled times (col. 8, line 55 – col. 9, line 25), with real-time dialogue in the form of Internet-based telephone conversation (col. 4, line 65 – col. 5, line 5; col. 6, lines 5-15).

21. For claim 4, Lauffer teaches wherein, in steps f-h), the client and the coach communicate over the Internet at scheduled times (col. 8, line 55 – col. 9, line 25), with real-time dialogue in

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the form of Internet-based video/audio conversation (col. 4, line 65 – col. 5, line 5; col. 6, lines 5-15).

22. For claim 5, Lauffer does not expressly disclose wherein there is provided for the coaches a web-based chat room to which said clients and the general public are denied access. Douglas teaches this limitation (col. 11, line 5 – col. 13, line 50). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advice and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

23. For claim 6, Lauffer does not expressly disclose wherein the coaching process includes providing to the clients incentives for reaching goals pertaining to the ongoing concern of the clients. Douglas teaches this limitation (col. 14, lines 35 – 55). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advice and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

24. For claim 7, Lauffer does not expressly disclose wherein the incentives include rewards provided to the clients for reaching said goals. Douglas teaches this limitation (col. 14, lines 35 – 55). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advice and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

25. For claim 8, Lauffer does not expressly disclose wherein the incentives include the awarding of points that are redeemable for rewards. Douglas teaches this limitation (col. 14,

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lines 35 – 55). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

26. For claim 9, Lauffer does not expressly disclose wherein there is provided for the clients a web-based chat room. Douglas teaches this limitation (col. 11, line 5 – col. 13, line 50). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

27. For claim 10, Lauffer does not expressly disclose wherein said clients' chat room is not accessible by the coaches and the general public. Douglas teaches this limitation (col. 11, line 5 – col. 13, line 50). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

28. For claim 11, Lauffer teaches wherein said method further comprises providing a publicly-accessible Web site that provides information about said coaching method (col. 5, lines 40-65).

29. For claim 12, Lauffer teaches wherein said Web site includes advertising of products or services not sold by the company, wherein entities other than the company pay the company to post said advertising on the Web site (col. 8, lines 20-30).



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30. For claim 13, Lauffer does not expressly disclose wherein products or services are offered for sale on said Web site. Douglas teaches this limitation (col. 14, lines 35 – 55). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

31. For claim 14, Lauffer teaches wherein clients are offered incentives to communicate, via the Internet, with prospective clients of the company about their experience with the coaching program (col. 8, lines 45-60).

32. For claim 15, Lauffer does not expressly disclose wherein there are periodic visits to the coaches' Web site by non-coach individuals with expertise in the subject of the clients' ongoing concern. Douglas teaches this limitation (col. 15, line 40 – col. 16, line 20). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

33. For claim 16, Lauffer does not expressly disclose wherein there are periodic visits to the clients' Web site by non-coach individuals with expertise in the subject of the clients' ongoing concern. Douglas teaches this limitation (col. 15, line 40 – col. 16, line 20). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

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34. For claim 19, Lauffer does not expressly disclose wherein said ongoing concern of the client pertains to stress. Douglas teaches this limitation (col. 6, line 50 – col. 7, line 40). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

35. For claim 21, Lauffer does not expressly disclose wherein said ongoing concern of the client pertains to depression. Douglas teaches this limitation (col. 5, lines 45-60). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

36. For claim 23, Lauffer does not expressly disclose wherein said ongoing concern of the client pertains to addiction. Douglas teaches this limitation (col. 5, lines 45-60). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

37. For claim 28, Lauffer does not expressly disclose wherein said ongoing concern of the client pertains to a chronic disease. Douglas teaches this limitation (col. 5, lines 45-60). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

38. For claim 31, Lauffer does not expressly disclose wherein said ongoing concern of the client pertains to elder care. Douglas teaches this limitation (col. 5, lines 45-60). It would have

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been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

39. For claim 32, Lauffer does not expressly disclose wherein said ongoing concern of the client pertains to caring for a disabled person. Douglas teaches this limitation (col. 5, lines 45-60). It would have been obvious to one skilled in the art to have modified Lauffer wherein the advise and information transmitted between the clients and experts is related to personal goals and health related because such advice can help the consumers/clients achieve better health and lifestyle.

40. For claim 34, Lauffer teaches wherein, during steps (f-h), both the client and the coach view monitors which display an electronically-stored file that contains a history of the setting and meeting of the client's goals, and wherein the client and coach communicate via Internet chat, conventional telephony, Internet telephony, or video, or a combination thereof, while said file is displayed (col. 7, lines 45-65).

41. For claim 35, Lauffer teaches wherein the client has access, between coaching sessions, to said electronically-stored file (col. 5, lines 45-65).

42. For claim 36, Lauffer teaches wherein, during steps (f-h), the coach is visible on the monitor of the client while the coach speaks (col. 9, lines 47-52).

43. For claim 37, Lauffer teaches wherein, during steps (f-h), the client's face is visible on the monitor of the coach while the client speaks (col. 9, lines 47-52).

44. For claim 38, Lauffer teaches wherein, during steps (f-h), the client is not shown on the coaches' monitor (col. 9, lines 5-15).

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45. For claim 39, Lauffer teaches wherein, during steps (f-h), the client is shown on the coaches' monitor (col. 9, lines 5-15).

46. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer and Douglas as applied to claim 40 above, and further in view of Brown (6,334,778).

47. For claim 20, Lauffer and Douglas do not expressly disclose wherein said ongoing concern of the client pertains to anxiety. Brown teaches this limitation (col. 12, lines 5-35). At the time the invention was made, one of ordinary skill in the art would have added the limitation to achieve better health and lifestyle (col. 2, lines 60-67).

48. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer and Douglas as applied to claim 40 above, and further in view of Knapp (6,278,999).

49. For claim 22, Lauffer and Douglas do not expressly disclose wherein said ongoing concern of the client pertains to pregnancy. Knapp teaches this limitation (col. 1, lines 45-65). At the time the invention was made, one of ordinary skill in the art would have added the limitation to achieve better health and lifestyle (col. 1, lines 45-65).

50. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer and Douglas as applied to claim 40 above, and further in view of Bro (5,722,418).

51. For claim 26, Lauffer and Douglas do not expressly disclose wherein said ongoing concern of the client pertains to menopause. Bro teaches this limitation (col. 11, line 33). At the

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time the invention was made, one of ordinary skill in the art would have added the limitation to achieve better health and lifestyle (col. 11, lines 10-55).

52. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer and Douglas as applied to claim 40 above, and further in view of Chein (5,855,920).

53. For claim 27, Lauffer and Douglas do not expressly disclose wherein said ongoing concern of the client pertains to andropause. Chein teaches this limitation (col. 14, lines 25-30). At the time the invention was made, one of ordinary skill in the art would have added the limitation to achieve better health and lifestyle (col. 2, line 65 – col. 3, line 10).

#### *Conclusion*

54. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They regard further teachings on the usage of nutritional and medical coaching systems, and on mentoring techniques.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melvin H Pollack  
Examiner  
Art Unit 2145

MHP  
07 February 2007



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